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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,746	01/15/2004	Matthias Konrad	03/005 MFE	4292

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EXAMINER

TRAN, THAO T

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/757,746

Applicant(s)

KONRAD ET AL.

Examiner

Thao T. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,7-11,13-20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,7-11,13-20 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the Amendments filed on 7/31/2006.
2. Claims 1-3, 7-11, 13-20, and 22 are currently pending in this application. Claims 1, 7-9, 11, 13-14 have been amended. Claim 22 has been newly added. Claims 4-6, 12, and 21 have been canceled.
3. The prior art rejections are maintained below. In addition, there are new claim objection of claim 3, and 112 rejections of claims 7 and 9.

Claim Objections

4. Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 3 recites the overlayer (A) comprising poly(m-xylenedipamide), which is already recited in parent claim 1.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which

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it is most nearly connected, to make and/or use the invention. Claim 1 recites the overlayer (A) not including poly(m-xylenedipamide), which is in conflict with the inclusion of the polymer in its parent claim 1.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites the limitation "the thermoplastic polyester" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 1-3, 7-11, 13-18, 20, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Kobayashi et al. (US Pat. 4,957,980).

Kobayashi teaches a multilayered polyester film for packaging and a method of making, the polyester film comprises a polyester resin composition having 100 parts by weight of a thermoplastic polyester resin and 1-100 parts by weight of a polyamide resin, or specifically 90 parts of the polyester resin and 5 parts of the polyamide resin containing m-xylylenedipamide (MXD) (see abstract; col. 1, l. 29-35; col. 2, ln. 53-62; Table 1, Example 1), and additives such as antioxidants or UV absorbing agents or antistatic agents (stabilizers) (see 4, ln. 10-14).

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Kobayashi further teaches the polyester resin is composed of repeating units of terephthalate, isophthalate, or naphthalene, and ethylene glycol (see col. 2, ln. 28-45). In Example 1, Kobayashi discloses the use of 5% by weight of MDX in the composition, reading on the presently claimed invention.

Kobayashi further discloses the multilayered polyester film being formed by extrusion and biaxial orientation (see col. 4, ln. 49-52). The film has an oxygen permeation of 35cc/m².d.atm (.35cc/bottle (1000cc).d.atm) and an opacity of 6% (haze) (see col. 5, ln. 17-21; Table 1, Example 1).

Although the reference does not specifically teach the gloss, planar orientation, and roughness values of the overlayer, since the reference teaches the same chemical components of the multilayer, the overlayer would inherently have the same gloss, planar orientation, and roughness as presently claimed.

Since claim 16 recites a filler including 0% concentration, the filler is not required.

Claim Rejections - 35 USC § 103

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi as applied to claim 1 above.

Kobayashi is as set forth in claim 1 above and incorporated herein.

Kobayashi further teaches that at least one of the layers is made of the polyester resin containing a polyamide resin having m-xylene groups (see abstract). Kobayashi further discloses

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in the background section of the invention that a thermoplastic polyester resin not including polyamide containing m-xylene has been widely used in the art.

Therefore, it would have been obvious to one of ordinary skill in the art that at least one of the layers of the molded article would have been of a polyester resin without the addition of a polyamide containing m-xylene, since this resin has been a conventional resin commonly used in the art in the production of molded articles in packaging that provides excellent mechanical properties, transparency, chemical resistance, and excellent processing properties (see col. 1, ln. 18-28).

Response to Arguments

13. Applicant's arguments filed on 7/31/2006 have been fully considered but they are not persuasive.

In response to Applicants' arguments that Kobayashi uses a compatibilizer to improve the optical properties of articles made from polyester/polyamide blends, it is noted that while this is true, the amount of the compatibilizer is not the only parameter determining the degree of transparency of the layer, but the combination of all three components whether they are present or absent (see Table 1 for various compositions and transparencies). Examples 1 and 8 have different amounts of the compatibilizer but the same transparencies.

Applicants further argue that the presently claimed invention differs from Kobayashi '980 in that the presently claimed invention comprises the MXD6-containing polyester films having at least one overlayer including either no or very moderate amounts of MXD6 to obtain improved barrier properties and surface gloss. However, as shown in Table 1 in Kobayashi '980,

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the amount of MXD used are 5%, 10%, and 20%, which read on the instantly claimed range.

Thus, the polyester films of Kobayashi would inherently have the same properties, such as barrier properties, orientation, and surface gloss as presently claimed.

In summary, Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections. Applicants are reminded that in an article claim, it is the structural or chemical components, and not properties, that impart patentability. To patentably distinguish the presently claimed invention from the prior art, Applicants should provide structural or chemical elements that give the films their properties different from the prior art.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 571-272-1080. The examiner can normally be reached on Monday-Friday, from 9:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Thao T. Tran
Primary Examiner
Art Unit 1711

tt
October 12, 2006